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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,485	08/18/2003	Ming-Bi Weng	BP3021-W8-P4	1865

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EXAMINER	
NEGRON, ISMAEL	

ART UNIT	PAPER NUMBER
2875	

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/642,485	WENG, MING-BI	
	Examiner	Art Unit	
	Ismael Negron	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 August 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Title

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: **Sequence Lighting System for Footwear.**

Drawings

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "**10**" has been used to designate different parts in different embodiments. See Figures 3 and 5.

In addition, note reference character "**103**" in Figures 3 and 5.

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 4 is objected to because of the following informalities: line 5 should read "even if the switch turns "on". Appropriate correction is required.

6. Claim 14 is objected to because of the following informalities: it contains multiple periods (".") in the body of the claim (see lines 3 and 4). Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claim except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2nd 1211(D.D.C. 1995). Appropriate correction is required.

Specification

7. The disclosure is objected to because of the following informalities: page 1, line 5 should read: "present invention~~, which also the applicant of the present invention~~.".

Appropriate correction is required.

8. The disclosure is objected to because of the following informalities: page 1, line 21 should read: "footwear lighting systems that produce flashing lights, ~~These~~ these".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by WONG (U.S. Pat. 5,969,479).

WONG discloses a light flashing system having:

- **a light source display sequence driver (as recited in Claim 1)**, Figure 6, reference number 64;
- **a plurality of light sources (as recited in Claim 1)**, Figure 6, reference numbers 80, 82 and 84;
- **the driver being for driving the plurality of light sources (as recited in Claim 1)**, column 6, lines 25-44;
- **the driver including a plurality of flash sequences (as recited in Claim 1)**, as evidenced by column 8, lines 41-67;
- **the flash sequences being for flashing the light sources (as recited in Claim 1)**, as evidenced by column 8, lines 41-67;
- **the driver including a plurality of dummy sequences (as recited in Claim 1)**, as evidenced by column 7, lines 8-14;

- **the dummy sequences being for flashing no light sources (as recited in Claim 1)**, as evidenced by column 7, lines 8-14; and
- **the dummy sequence is arranged in one of a plurality of positions including before flash of the normal sequence, between two normal sequences, and after flashing of the normal sequence (as recited in Claim 14)**, inherent.

In addition, WONG discloses light flashing system having:

- **a plurality of light emitting sources (as recited in Claim 2)**, Figure 6, reference numbers 80, 82 and 84;
- **a power source (as recited in Claim 2)**, Figure 6, reference number 62;
- **the power source being for providing power (as recited in Claim 2)**, column 6, lines 15 and 16;
- **a switch (as recited in Claim 2)**, Figure 7, reference number 102;
- **the switch turning ON or OFF responsive to motions of a footwear (as recited in Claim 2)**, column 11, lines 28-32;
- **a key trigger (as recited in Claim 2)**, Figure 6, reference number 66;
- **the trigger being activated in response to the turning ON of the switch in an actuating period (as recited in Claim 2)**, as evidenced by column 7, lines 39--42;

- **the trigger being inactive in response to an inactive time period (as recited in Claim 2)**, column 7, lines 12-14;
- **a light source display sequence driver (as recited in Claim 2)**, Figure 6, reference number 78;
- **the driver being for driving the light sources to flash (as recited in Claim 2)**, as evidenced in Figure 6;
- **the driver including a plurality of normal sequences for flashing the light sources (as recited in Claim 2)**, inherent;
- **the driver also including a plurality of dummy sequences for flashing no light sources (as recited in Claim 2)**, inherent;
- **a sequence input key (as recited in Claim 3)**, Figure 6, reference number 68;
- **the key having a plurality of inputs for determining a flashing sequence of the light sources (as recited in Claim 3)**, as seen in Figure 6;
- **the driver including an inactive time generator (as recited in Claim 4)**, Figure 6, reference number 92;
- **the generator being for generating an inactive time period to the key trigger (as recited in Claim 4)**, inherent;
- **the trigger being inactive during the inactive time period even if the switch turns ON (as recited in Claim 4)**, column 7, lines 12-14;

- **the driver including a controller (as recited in Claim 5)**, as evidenced by Figure 6;
- **the controller receiving inputs from the key trigger and sequence input key (as recited in Claim 5)**, as evidenced by Figure 6;
- **the controller causing the light sources to emit light in response to a selective sequence from the sequence input key (as recited in Claim 5)**, as seen in Figure 6;
- **the controller being actuated by the key trigger (as recited in Claim 6)**, as seen in Figure 6;
- **the driver including a sequence selector (as recited in Claim 7)**, Figure 6, reference number 78;
- **the selector being for actuating a sequence for displaying the light sources (as recited in Claim 7)**, inherent;
- **the driver including a sequence selector (as recited in Claim 8)**, Figure 6, reference number 78;
- **the selector being for actuating a sequence for displaying the light sources according to the indication from the controller (as recited in Claim 8)**, as evidenced by Figure 6;
- **the selector actuating the inactive time generator for generating an inactive time period according to a selected**

sequence from the controller (as recited in Claim 8), as evidenced by Figure 6;

- **the driver having a normal sequence block (as recited in Claim 9)**, inherent;
- **the block storing a plurality of sequences for actuating the light sources (as recited in Claim 9)**, inherent;
- **the block actuating a selected sequence in response to an indication from the selector (as recited in Claim 9)**, as evidenced by Figure 6;
- **the driver having a dummy sequence block (as recited in Claim 10)**, as evidenced by column 7, lines 12-14;
- **the dummy block storing a plurality of dummy sequences which do not actuate any light sources (as recited in Claim 10)**, inherent;
- **a sequence input key (as recited in Claim 11)**, Figure 6, reference number 68; and
- **the input key being for inputting a flash sequence of the light sources to the light source display sequence driver (as recited in Claim 11)**, as seen in Figure 6.

WONG further discloses the light flashing system to be use in footwear, however, the applicant is advised that the recitation "for a footwear" (lines 1 and 2, of claims 1 and 2) amounts to a recitation of the intended use of the patented invention, without

resulting in any structural difference between the claimed invention and the structure disclosed by the Prior ART. Even if WONG were silent as to the patented system being used in footwear, such recitation would still fail to patentably distinguish the claimed invention from the Prior Art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WONG (U.S. Pat. 5,969,479).

WONG discloses light flashing system having:

- **a plurality of light emitting sources (as recited in Claim 2)**, Figure 6, reference numbers 80, 82 and 84;
- **a power source (as recited in Claim 2)**, Figure 6, reference number 62;
- **the power source being for providing power (as recited in Claim 2)**, column 6, lines 15 and 16;
- **a switch (as recited in Claim 2)**, Figure 7, reference number 102;

- **the switch turning ON or OFF responsive to motions of a footwear (as recited in Claim 2)**, column 11, lines 28-32;
- **a key trigger (as recited in Claim 2)**, Figure 6, reference number 66;
- **the trigger being activated in response to the turning ON of the switch in an actuating period (as recited in Claim 2)**, as evidenced by column 7, lines 39--42;
- **the trigger being inactive in response to an inactive time period (as recited in Claim 2)**, column 7, lines 12-14;
- **a light source display sequence driver (as recited in Claim 2)**, Figure 6, reference number 78;
- **the driver being for driving the light sources to flash (as recited in Claim 2)**, as evidenced in Figure 6;
- **the driver including a plurality of normal sequences for flashing the light sources (as recited in Claim 2)**, inherent;
- **the driver also including a plurality of dummy sequences for flashing no light sources (as recited in Claim 2)**, inherent;
- **a sequence input key (as recited in Claim 3)**, Figure 6, reference number 68;
- **the key having a plurality of inputs for determining a flashing sequence of the light sources (as recited in Claim 3)**, as seen in Figure 6;

- **the driver including an inactive time generator (as recited in Claim 4)**, Figure 6, reference number 92;
- **the generator being for generating an inactive time period to the key trigger (as recited in Claim 4)**, inherent;
- **the trigger being inactive during the inactive time period even if the switch turns ON (as recited in Claim 4)**, column 7, lines 12-14;
- **the driver including a controller (as recited in Claim 5)**, as evidenced by Figure 6;
- **the controller receiving inputs from the key trigger and sequence input key (as recited in Claim 5)**, as evidenced by Figure 6; and
- **the controller causing the light sources to emit light in response to a selective sequence from the sequence input key (as recited in Claim 5)**, as seen in Figure 6.

WONG discloses all the limitation of the claims, except:

- the controller randomly determines a sequence for the illumination of the light sources (as recited in Claim 12); and
- a random generator is used to determine an order of the dummy sequence and normal sequence (as recited in Claim 13).

The examiner takes Official Notice that the use of random illumination patterns is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use random illumination patterns (as recited in claims 12 and 13) in the system of WONG. One would have been motivated since random illumination patterns are recognized in the illumination art to have many desirable advantages, including increased visibility and aesthetic value, over other regularly repetitive patterns.

Relevant Prior Art

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chung-Piao (U.S. Pat. 5,177,467), **Weng et al**. (U.S. Pat. Nos. 5,663,614 and 5,812,063) and **Garner** (U.S. Pat. 5,903,103) disclose a plurality of light flashing systems having a plurality of illumination patterns determined by the conditions sense by different types of movement sensors.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-

2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to http://pair-direct.uspto.gov. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.

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Patent Examiner
2875

lnr

March 4, 2005